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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,506	07/15/2005	John L. Holahan	SITH 9317W1	5924
1688 7590 07/23/2009 POLSTER, LIEDER, WOODRUFF & LUCCHESI 12412 POWERSCOURT DRIVE SUITE 200 ST. LOUIS, MO 63131-3615			EXAMINER JONES, DAMERON LEVEST	
			ART UNIT 1618	PAPER NUMBER
			MAIL DATE 07/23/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/542,506

**Applicant(s)**

HOLAHAN, JOHN L.

**Examiner**

D L. Jones

**Art Unit**

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-850)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date See Continuation Sheet

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7/15/05; 11/17/05; 1/3/06; 4/10/07; 4/2/08; & 6/18/09.

### ACKNOWLEDGEMENTS

1. The Examiner acknowledges receipt of the amendment filed 6/18/09 wherein claims 1-38 and 46-56 were canceled.

**Note:** Claims 39-45 are pending.

### APPLICANT'S INVENTION

2. Applicant's invention is directed to a process for the production of homogeneous single phase thickened beverages.

### APPLICANT'S ELECTION OF SPECIES

3. Applicant's election of Group V (claims 39-45) in the reply filed on 6/18/09 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Thus, the restriction is deemed proper and is made FINAL.

### 112 FIRST PARAGRAPH REJECTION

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 39-45 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The essential steps necessary to producing homogenous single phase thickened beverages are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

## 112 SECOND PARAGRAPH REJECTION

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 39-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 40: The claim as written is ambiguous because of the phrase 'whether the beverage thickness is increased by inclusion of the thickener concentrate or not'. In particular, the phrase is indefinite because it does not flow with the previous portion of the sentence that the homogeneous mixture. In other words, the wording is awkward and does not exemplify what is being claimed. Please clarify in order that one may ascertain what is being claimed.

Claim 41: The claim as written is ambiguous because of the phrase 'or and liquid foods exit the dispenser at the correct thickness'. In particular, the wording is awkward and one cannot ascertain what is being claimed.

Claim 41, line 3: The claim as written is ambiguous because of the phrase 'narrow gap'. The phrase "narrow gap" in claim 41, line 3, is a relative term which renders the claim indefinite. The phrase "narrow gap" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 42: A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 42, lines 2-3, recites the broad recitation 'alginates' and the claim also recites sodium alginates, potassium alginates, and ammonium alginates, which is the narrower statement of the range/limitation.

Claims 39-45 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the steps necessary for the production of homogeneous single phase thickened beverages.

## **102 REJECTIONS**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 39-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Wierlo (US Patent No. 3,839,407).

**Wierlo** discloses an apparatus for mixing thickened substances. The apparatus comprises a dispensing nozzle and a combination agitator-mixer-scraper. In addition, Wierlo discloses that unflavored substances such as ice cream, milkshakes, slush, ice, or frozen custard flows toward and exit nozzle the substance comes in contact flavored syrup (see entire document, especially, abstract; column 1, lines 6-13; column 2, lines 15-18). In the detailed description of the drawings, the details of the apparatus disclose that the dispense machine comprises a compressor motor, various storage tank, and optionally, a pump (column 2, lines 24-46). Thus, both Applicant and Wierlo disclose a process for the production of a homogenous single phase thickened beverage.

#### **COMMENTS/NOTES**

10. Applicant is reminded that it has been held that the recitation that an element is 'capable of' performing a function is not a positive limitation, but only requires the ability to so perform that function. Thus, such terminology does not constitute a limitation in any patentable sense (In re Hutchison, 69 USPQ 138).

11. It should be noted that essential process steps are missing from the claims. The description of the thickener, for example, absent process steps are not further limiting of the process of producing the thickened beverages because it is unclear how Applicant

intended to incorporate the limitations in the process steps. Thus, Applicant is respectfully requested to clarify the claims in order that one may ascertain what is being claimed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D L. Jones whose telephone number is (571)272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D L. Jones/  
Primary Examiner  
Art Unit 1618

July 19, 2009